

REMARKS

INTRODUCTION:

In accordance with the foregoing, the specification and claim 1 has been amended, claims 2, 3, and 5-11 have been cancelled, and claims 12-15 have been added. No new matter is being presented, and approval and entry are respectfully requested.

Claims 1, 4, and 12-15 are pending and under consideration.

MPEP 809.03(B) recites that "a claim to the necessary process of making a product linking proper process and product claims" is a linking claim. Applicants respectfully submit that new method claims 14 and 15 are linking claims, and therefore claims 14 and 15 should be examined in the current application.

CLAIM OBJECTION:

In the Office Action, at page 2, the Examiner objected to claim 2 for the reasons set forth therein.

Claim 2 has been cancelled.

REJECTION UNDER 35 U.S.C. § 112:

In the Office Action, at page 2, third paragraph, the Examiner rejected claims 5-11 under 35 U.S.C. § 112, second paragraph, for the reasons set forth therein.

Claims 5-11 have been cancelled.

REJECTION UNDER 35 U.S.C. §102:

In the Office Action, at page 2, the Examiner rejected claims 1-6, and 8 under 35 U.S.C. §102(b) as being anticipated by Ito et al. (Japanese Patent No. 2002-206542 – hereinafter Ito). The reasons for the rejection are set forth in the Office Action and therefore not repeated. Applicants traverse this rejection and respectfully request reconsideration.

Amended, independent claim 1 recites: "...a tool reference plane defined in at least one of opposite sides of the raceway groove of the raceway member, the tool reference plane being utilizable for a process of finishing the electrically insulating layer or for a thickness control of the insulating layer, wherein the tool reference plane is defined by a bare surface area in the end face of the raceway member, which is left uncovered by the insulating layer."

Ito appears to disclose a method of manufacturing an electrocorrosion preventive rolling bearing assembly, in which an inner peripheral surface of an outer race member is used as a reference surface during a machining of an electrically insulating layer, and in which a support fixture supports such reference surface during the machining of the electrically insulating layer.

But Applicants respectfully submit that Ito does not disclose or suggest using a bare surface area in an end face of a raceway member, which is left uncovered by the insulating layer, as a tool reference surface for a process of finishing the electrically insulating layer or for a thickness control of the insulating layer.

In contrast, in a non-limiting embodiment, the present invention offers advantages of finishing the insulating layer or controlling a film thickness in a simplified structure by utilizing the base surface area as a tool reference plane.

Accordingly, Applicants respectfully submit that independent claim 1 patentably distinguishes over the cited art, and should be allowable for at least the above-mentioned reasons. Further, Applicants respectfully submit that claim 4, which depends from independent claim 1, should be allowable for at least the same reasons as claim 1, as well as for the additional features recited therein.

REJECTIONS UNDER 35 U.S.C. §103:

In the Office Action, at page 3, the Examiner rejected claims 7 and 11 under 35 U.S.C. §103(a) as being unpatentable over Ito.

In the Office Action, at page 3, the Examiner rejected claims 9 and 10 under 35 U.S.C. § 103(a) as being unpatentable over Ito, and further in view of Mizutani et al. (U.S Patent No. 5,375,933 – hereinafter Mizutani).

Claims 7, 9, 10, and 11 have been cancelled.

NEW CLAIMS:

Applicants respectfully submit that for at least similar reasons as those stated in the section regarding the rejection under 35 U.S.C. §102, new claims 12 and 13 patentably distinguish over the cited art and should be allowable. Additionally, Applicants respectfully submit that new claims 14 and 15 also distinguish over the cited art.

CONCLUSION:

In accordance with the foregoing, Applicants respectfully submit that all outstanding objections and rejections have been overcome and/or rendered moot, and further, that all pending claims patentably distinguish over the cited art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited by the Examiner contacting the undersigned attorney for a telephone interview to discuss resolution of such issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: August 25, 2005

By: *Michael A. Bush*
Michael A. Bush
Registration No. 48,893

1201 New York Avenue, NW, Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501